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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,159	02/05/2002	Bernard Bihain	29.US4.DIV	2627

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EXAMINER

CHANDRA, GYAN

ART UNIT PAPER NUMBER

1646

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/072,159

Applicant(s)

BIHAIN ET AL.

Examiner

Gyan Chandra

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 91-93, 98, 106 and 110-123 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 91-93, 98, 106 and 110-123 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/19/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/19/2005 has been entered.

### **Status of Application, Amendments, And/Or Claims**

Claims 1-90, 94-97, 99-105 and 107-109 are canceled.

The amendment of claim 91 and the addition of new claims 110-123 have been made of record.

Claims 91-93, 98, 106 and 110-123 are pending. Applicants point that the requirement for the species election between the partitioning of dietary lipid, the reduction of free fatty acids and the decrease in body weight was withdrawn in the Office Action of 12.27/2004, therefore claims 91-93, 98, 106 and 110-123 are under examination.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) filed on 12/19/2005 has been considered.

***Claim Rejections-withdrawn***

***Claim Rejections - 35 USC § 112- written description***

The rejection of claim 91 under 35 USC § 112, first paragraph- written description is withdrawn due to the amendment of the claim filed on 12/19/2005.

***Claim Rejections - 35 USC § 112- enablement***

The rejection of claims 91-109 under 35 USC § 112, first paragraph- enablement is withdrawn due to the amendment of claim 91 and cancellation of claims 94-97, 99-105 and 107-109 as filed on 12/19/2005.

***Response to Arguments***

Applicant's arguments, see Remarks, filed 12/19/2006, with respect to the examination of claim(s) 91-93, 98, 106 and 110-123 together as indicated in the Office Action of 12.27/2004 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Obviousness-type Double Patenting (ODP).

***New Ground(s) of Rejection***

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 91-93, 98, 106 and 110-123 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,946,444. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of treating obesity related insulin resistance and treating a condition to increase the partitioning of dietary lipids to the liver, reducing the levels of fatty acids in obese subjects, decreasing the body weight of obese individuals or treating an obesity related condition comprising administering a composition comprising an apM1 comprising SEQ ID NO: 11 are taught in column 28, Example 10, and as claimed in claims 1-14 of US Patent No. 6,946,444.

Claims 91-93, 98, 106 and 110-123 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and Example 10 of U.S. Patent No. 6,344,441. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of treating obesity

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related insulin resistance and treating a condition to increase the partitioning of dietary lipids to the liver, reducing the levels of fatty acids in obese subjects, decreasing the body weight of obese individuals or treating an obesity related condition comprising administering a composition comprising an apM1 comprising SEQ ID NO: 11 are taught in Example 10, and as claimed in claims 1-4 of US Patent No. 6,344,441.

Claims 91-93, 98, 106 and 110-123 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and Examples 4-16 of U.S. Patent No. 6,566,332. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of treating obesity related insulin resistance and treating a condition to increase the partitioning of dietary lipids to the liver, reducing the levels of fatty acids in obese subjects, decreasing the body weight of obese individuals or treating an obesity related condition comprising administering a composition comprising an apM1 comprising SEQ ID NO: 11 are taught in Examples 4-16 of US Patent No. 6,566,332.

Claims 91-93, 98, 106 and 110-123 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-26 and Examples 4-16 of U.S. Patent No. 6, 989,367. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of treating obesity related insulin resistance and treating a condition to increase the partitioning of dietary lipids to the liver, reducing the levels of fatty acids in obese

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subjects, decreasing the body weight of obese individuals or treating an obesity related condition comprising administering a composition comprising an apM1 comprising SEQ ID NO: 11 are taught in claims 13-26 and in Examples 4-16 of US Patent No. 6,989,367.

***Conclusion***

No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gyan Chandra whose telephone number is (571) 272-2922. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gyan Chandra, Ph.D.  
Art Unit 1646  
28 February 2006  
Fax: 571-273-2922

**EILEEN B. O'HARA**  
**PRIMARY EXAMINER**